

REMARKS

I. Interview Summary

Applicants wish to thank Examiner Champagne for the courtesy of conducting a telephonic interview on June 24, 2009. The claims and rejections were discussed.

II. Preliminary Matter

As a preliminary matter, Applicants note that the Office Action mailed May 12, 2009 ("Office Action") did not state any rejection against claim 38. As such, Applicants respectfully request that any subsequent future Office Action which offers statutory grounds for rejecting this claim should be made non-final. See MPEP §706.07(a) ("[S]econd or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)").

III. Claim Rejections – 35 U.S.C. §101

Claims 1 and 3-37 stand rejected under 35 U.S.C. §101 regarding statutory subject matter. Claims 1 and 3-37 have been amended for the sake of clarity. The claims as amended contain no new matter and are supported by the Specification as filed. Applicants respectfully request that the 35 U.S.C. 101 rejections to these claims be withdrawn.

IV. Claim Rejections – 35 U.S.C. §112

Claims 1 and 3-37 stand rejected under 35 U.S.C. §112, 1st paragraph regarding enablement of the feature "calculating performance scores." Additionally, claims 1 and 3-37 stand rejected under 35 U.S.C. §112, 2nd paragraph regarding indefiniteness. Applicants note that while the Office Action initially states rejections under §112, 1st paragraph and §112, 2nd paragraph

distinctly (Office Action, p. 3), it later addresses the two rejections jointly (Office Action, pp. 6-7).

A. 35 U.S.C. §112, 1st paragraph

1. *The Claims Are Enabled*

The MPEP, in describing the enablement requirement, states that “[t]he information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention.” MPEP §2164. “As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.” MPEP §2164.01(b).

Applicants’ claims, including the feature “calculating performance scores,” are enabled in the Specification by at least the formulas and processes described in paragraphs 0051 – 0086. At a minimum, these paragraphs provide ample descriptions of potential data and inputs, as well as processes, algorithms, and methods for determining various performance scores. The expansive disclosure found in at least these paragraphs is fully sufficient to enable one of ordinary skill in the art to make and use the claimed invention. Indeed, Applicants note that the Office Action appears to concede this point, stating that “[t]he spec. does give formulas which might qualify as an algorithm [for its calculation means].” Office Action, p. 6.

Applicants assert that because the Specification provides at least one way in which one of ordinary skill in the art could calculate performance scores, this feature has been sufficiently enabled. See e.g. MPEP §2164.04. As such, Applicants respectfully request that the §112, 1st paragraph rejections to claims 1 and 3-37 be withdrawn.

2. *Applicants’ Response to the Office Action’s Improper Enablement Argument*

The Office Action offers a confusing and incorrect interpretation of the law surrounding the §112 requirement of patentability, attempting to cite inapposite MPEP sections in support of such statements. For example, the Office Action states on page 3: “[C]alculating performance scores’ is not enabled because a person skilled in the art would not be able to practice the invention without undue experimentation (MPEP § 2164-2164.08(c)). ‘Practice’ in the instant context means being able to achieve a repeatable result (a so-called ‘concrete’ result, MPEP §2106.IV.C.2(2)c)).” This statement is improper for at least three reasons.

First, MPEP §2106.IV.C.2(2)(c) does not state anywhere that “practice” means “being able to achieve a repeatable result.” Nor could the Applicants find any definition in the MPEP of the word “practice.”

Second, even if this cited section of the MPEP did support the definition provided by the Office Action (which it does not), this section of the MPEP is directed towards §101 rejections, which constitute an entirely separate and distinct statutory rejection. See MPEP §2106.IV.C (Titled “Determine Whether the Claimed Invention Falls Within 35 U.S.C. 101 Judicial Exceptions - Laws of Nature, Natural Phenomena and Abstract Ideas”). This section is concerned with statutory subject matter, and not enablement or indefiniteness requirements under 35 U.S.C. §112.

Third the Office Action’s assertion of undue experimentation in this case, where at least one embodiment has already been disclosed which is enabling, is inconsistent with similar examples provided in the MPEP. Section §2164.06 of the MPEP, titled “EXAMPLE OF REASONABLE EXPERIMENTATION,” describes a Federal Circuit decision involving nearly identical circumstances to those presented by this application. In that case, the Court found that a disclosure in the specification of even just one embodiment or way to perform a method was sufficient to meet the enablement requirements of §112, and further eliminated any concerns of undue experimentation. As the MPEP summarized, “[t]he court ruled that since one embodiment ... and the method ... was set forth in the specification, the specification was enabling.” MPEP §2164.06; see United States v. Teletronics, Inc., 857 F.2d 778 (Fed. Cir. 1988), cert. denied, 490 U.S.

1046 (1989). Like the situation in Telectronics, the present Specification offers at least one way in which one of ordinary skill in the art could calculate performance scores. As stated in the MPEP, this disclosure is enabling and represents an example of reasonable experimentation.

Applicants note that the Office Action provides further commentary on its §112, 1st paragraph rejections which is intermingled with its §112, 2nd paragraph analysis, and is discussed in further detail below.

Applicants respectfully assert that, for at least the reasons described above, the present claims are fully enabled, and therefore respectfully requests that the §112, 1st paragraph rejections to claims 1 and 3-37 be withdrawn.

B. 35 U.S.C. §112, 2nd paragraph

1. *The Claims Are Not Indefinite*

The Office Action, citing Aristocrat, states that “‘calculating performance scores’ is indefinite because the applicant has failed to disclose any objective means or algorithm by which to identify said plurality of products.” Office Action, p. 3.

The MPEP states that “[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) [t]he content of the particular application disclosure; (B) [t]he teachings of the prior art; and (C) [t]he claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” MPEP §2173.02. “The test for definiteness under 35 U.S.C. 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” MPEP §2173.02 (citing Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986)) (emphasis added).

“Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.” MPEP §2173.02 (citing Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354 (Fed. Cir. 2004)).

As previously shown with respect to the enablement requirement above, Applicants' Specification offers a clear disclosure of at least one method of calculating performance scores in at least paragraphs 0051-0086, thereby alleviating the concerns stated in the Office Action regarding disclosure of an objective means or algorithm. Further, the claim language, when given all reasonable attempts at construction and analyzed in light of the content of the Specification, the teachings of the prior art, and the claim interpretation of one of ordinary skill, offers a clear definition of what is claimed by the disclosure in at least the above-mentioned paragraphs of the Specification. It is indisputable that the claims, read in such a light, are not merely insolubly ambiguous, but rather are clear and definite.

Applicants also oppose the Office Action's citation of Aristocrat in support of this rejection. The holding in Aristocrat exclusively addressed means plus function claims, and thus is inapplicable to at least claims 1 and 3-19, which do not recite means plus function language. With respect to any means plus function claims in the present application, Aristocrat is not analogous. The plaintiff in that case had merely disclosed a standard microprocessor and the phrase "appropriate programming" while attempting to claim a gaming machine with a game control to display images, pay a prize, and define pay lines for the game. No formulas or processes for the programming were disclosed by the plaintiff. As such, the disclosure in Aristocrat is vastly different from the disclosure here (see at least paragraphs 0051 – 0086), where the Specification offers explicit formulas and processes by which performance scores may be calculated.

For at least each of the reasons given above, claims 1 and 3-37 are not indefinite. As such, Applicants respectfully request that the §112, 2nd paragraph rejections to these claims regarding indefiniteness be withdrawn.

2. Applicants' Response to the Office Action's Improper Indefiniteness Argument

The Office Action relies upon an unsupported “clear definition standard” in making its §112 rejections, stating that the “problem is the legal concept of *clear definition*. Unless a term is given a ‘clear definition’ in the specification (MPEP §211.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification.” Office Action, p. 6 (emphasis original). According to the Office Action, “[t]he instant application contains no algorithm or other *clear definition* for its calculation means.” (Office Action, p. 6).

Further to this supposed standard, the Office Action relies on statements it made in the Office Action mailed January 5, 2009, which declared without citation that:

“A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as ‘by xxx we mean’; ‘xxx is defined as’; or ‘xxx includes, ... but does not include ...’. An example does not constitute a ‘clear definition’ beyond the scope of the example.”

Applicants request clarification or removal of this rejection. To the knowledge of the Applicants, no “clear definition standard” exists for a claim to satisfy the patentability requirements of §112 1st or 2nd paragraphs. Further to this point, the language contained in the block-quote above does not appear anywhere in the MPEP.

Applicants point out that, as conceded by the Office Action, if a term is not given a “clear definition,” an examiner must give the claim its broadest interpretation. The MPEP does not say that such a failure to provide a “clear definition,” which may result in the broadest reasonable interpretation, makes the claims indefinite. Rather, “[b]readth of a claim is not to be equated with indefiniteness.” MPEP §2173.04 (emphasis added).

Additionally, the Office Action’s above-described strict “clear definition standard” runs counter to the policies and procedure enumerated in the MPEP. For example, MPEP §2173.02 states that “[o]ffice policy is not to employ per se rules to make technical rejections [of indefiniteness]. Examples of claim language which have been held to be indefinite ... are fact specific and should not be applied as per se rules.” (Emphasis added).

Along similar lines, the MPEP clearly states that examiners “should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.” MPEP §2173.02. “[I]f the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph.” MPEP §2173.02.

While Applicants find the above “clear definition standard” improper for the reasons stated above, Applicants do point out that, as described with respect to enablement, the Specification provides disclosure for calculating performance scores. Additionally, Applicants assert that their claims, when analyzed under the proper approach described above and given all reasonable attempts at construction as required by the MPEP, are clear and not indefinite. For all of the reasons previously provided, Applicants respectfully request that the §112, 2nd paragraph rejections to claims 1 and 3-37 regarding indefiniteness be withdrawn.

C. 35 U.S.C. §112, 2nd paragraph – Improper Markush Group

Additionally, claim 37 has been further rejected under 35 U.S.C. §112, 2nd paragraph regarding Markush groups. Applicants respectfully assert that the rejection has been obviated by appropriate amendment, and therefore respectfully requests that the rejection be withdrawn.

V. Applicability of 35 U.S.C. §112, 6th paragraph

Applicants thank the Examiner for correctly noting that any proper means plus function interpretation must include equivalents. However, the present Office Action, like the two before it, appears to limit or restrict the interpretation of any means plus function language in the claims to portions of the Specification “specifically at para. [0096] *et seq.*” and equivalents thereof. Office Action, p. 4. Applicants do not agree with the Office Action’s attempt to limit the portion of the Specification considered during interpretation to paragraphs [0096] *et seq.* “The USPTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application.” MPEP §2181. Applicants respectfully oppose any interpretation of any pending claim that incorporates means plus function claim language where such an interpretation gives the claim an interpretation less than its broadest reasonable interpretation.

VI. Claim Rejections – 35 U.S.C. §102(e)

Claims 1, 3-9, 11, 14, 16-28, 30, and 34-37 stand rejected under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. 2002/0042738 (“Srinivasan”).

A. Claims 1, 3-9, 11, 14, 16-19, and 37

Independent claim 1 recites, in part:

A computer readable medium containing an executable method ... comprising:

... collecting ... a plurality of outcome data points;

calculating ... performance scores based upon ... the outcome data points

... wherein the outcome data points include data points selected from the group consisting of:

data points identifying an enjoyability rating reflecting how enjoyable or annoying the advertisement was to the user, wherein the enjoyability rating corresponds to a rating on an enjoyability and annoyance scale;

data points identifying a relevance rating reflecting the relevance of the subject matter of the advertisement to the user, wherein the relevance rating corresponds to a rating on a degree of relevance scale; and

data points identifying an impact rating reflecting the impact of an advertisement on the user's opinion of the advertiser or media owner, wherein the impact rating corresponds to a rating on an impact scale.

Srinivasan teaches a "system [that] uses one or more objective functions for determining advertising effectiveness." Srinivasan at 0085 et seq. In Srinivasan, "[d]ata is accumulated for each advertisement. This data typically include the fraction of visitors who click-through a particular ad, for example. Other data may include whether or not the customer purchased a particular product or a minimum 'basket' of products." Srinivasan at 0104. "The ad with the highest click-rate, or other measurement of the objective function, is then used as the default advertisement." Srinivasan at 0106; see also Srinivasan example at 0114-0119. After such measurements, some advertisements may then be propagated to the visitors. Srinivasan at 0113.

However, the click-through rates, buy rates, and other objective data described in Srinivasan all fail to teach or suggest the existence of ratings of how enjoyable or annoying the advertisement was to the user, the relevance of the subject matter of the advertisement to the user, or the impact of an advertisement on the user's opinion of the advertiser or media owner. As such, Srinivasan fails to teach the features collecting a plurality of outcome data points and calculating performance scores based on the outcome data points, where the outcome data points include data points selected from the group consisting of data points identifying an enjoyability rating reflecting how enjoyable or annoying the advertisement was to the user, data points identifying a relevance rating reflecting the relevance of the subject matter of the advertisement to the user, data points identifying an impact rating reflecting the impact of an advertisement on the user's opinion of the advertiser or media owner.

Therefore, Applicants respectfully request the withdrawal of the §102 rejection to claim 1. Additionally, dependent claims 3-9, 11, 14, 16-19, and 37 all

depend from independent claim 1, and therefore include all of its features. As such, Applicants respectfully request that the §102 rejections of these claims also be withdrawn.

B. Claims 20-28, 30, and 34-36

Independent claim 20 recites, in part:

A computer readable medium containing a computer application ... comprising:

... data collecting means for collecting a plurality of data points identifying measurements of how enjoyable or annoying the advertisement was to the user, wherein said measurements correspond to ratings on an enjoyability and annoyance rating scale;

... calculating means for calculating performance scores from the plurality of data points.

As described in section V.A., Srinivasan fails to teach or suggest data collecting means for collecting a plurality of data points identifying measurements of how enjoyable or annoying the advertisement was to the user where the measurements correspond to ratings on an enjoyability and annoyance rating scale, and calculating means for calculating performance scores from the plurality of data points.

For at least these reasons, Applicants respectfully request the withdrawal of the §102 rejection to claim 20. Additionally, because dependent claims 21-28, 30, and 34-36 each contain all of the features of independent claim 20, Applicants also respectfully request that the §102 rejections to these claims also be withdrawn.

VII. Claim Rejections – 35 U.S.C. §103(a)

Claims 10, 12, 13, 15, 29, and 31-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Srinivasan. In making the present §103(a) rejections, the Examiner attempts to take official notice that pop-up windows were a common means of presenting surveys at the time of the instant invention,

asking for comments in the surveys was also common, and key-word analysis would have been an obvious mechanical efficiency in analyzing these comments.

Applicants respectfully contend that the above facts, even if true, fail to fill in the gaps of Srinivasan previously described with respect to independent claims 1 and 20. As such, Applicants respectfully request that the §103 rejections to claims 10, 12, 13, and 15, which each depend from independent claim 1 and contain all of its features, should be withdrawn. Additionally, because Srinivasan and the officially noticed facts fail to teach or suggest all of the features of independent claim 20, Applicants respectfully request that the §103 rejections to dependent claims 29 and 31-33, which each include all of the features of independent claim 20, also be withdrawn.

Applicants respectfully request that the Examiner provide an affidavit or declaration setting forth specific factual statements and an explanation to support the findings or provide Applicants with one or more references or other documentary evidence to support the findings.

In attempting to defend the taking of official notice, the Office Action includes unsupported statements with inaccurate and / or misapplied citations to the MPEP, while improperly shifting the burden of proving or disproving obviousness to Applicants.

The Office Action states that “applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03).” (Office Action, pp. 5-6) (emphasis original). However, the language quoted from the Office Action is **not** found in the current version of the cited MPEP section.

There is no indication in the MPEP that the burden is on Applicants to provide information or argument so that on its face it creates a reasonable doubt regarding the circumstances, or that “[a]n effective traverse must be based on compelling argument or alleged evidence, not mere denial.” (Office Action, p. 6). MPEP 2144.03 does not require this, but rather notes that “[t]o adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact

is not considered to be common knowledge or well-known in the art.” Applicants could find no requirement in the MPEP that an applicant must present “compelling argument or alleged evidence” to effectively traverse the official notice.

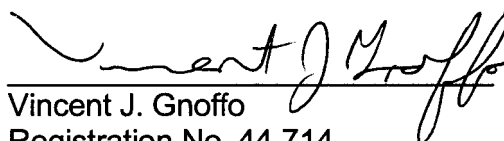
Indeed, such a requirement appears to run afoul to the only two examples of failures to adequately traverse an official notice given in MPEP 2144.03. The two situations where applicants are deemed to have failed to adequately traverse an official notice are where there exists an “absence of any demand by [applicant] for the examiner to produce authority for his statement” (Chevenard, 139 F.2d at 713); and when the applicant offers a general allegation of patentability “without any reference to the examiner’s assertion of official notice.” MPEP 2144.03. As stated in Applicants’ most recent response, neither situation exists here, since Applicants have both referenced the Office Action’s official notice and insisted upon documentary support for the facts officially noticed.

The MPEP clearly delineates that facts officially noticed must be “capable of such instant and unquestionable demonstration as to defy dispute.” MPEP 2144.03 (citing In re Knapp Monarch Co., 296 F.2d 230 (CCPA 1961)). “If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence.” (MPEP 2144.03(C)) (emphasis added). As the MPEP requires, the present facts at issue must be supported by documentary evidence, and as such, Applicants respectfully assert that documentary evidence illustrating these facts be provided.

VIII. Conclusion

Applicants respectfully request entry of this Amendment and allowance of this application. The Examiner is invited to contact the undersigned attorney for the Applicants via telephone if such communication would expedite this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Vincent J. Gnoffo", written over a horizontal line.

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